

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-26 are currently pending. Claims 7-12 and 18-26 stand withdrawn as directed to non-elected inventions. The present Amendment amends Claim 16. No claims have been added herewith.

In the outstanding Office Action, the drawings were objected to under MPEP § 608.02(g). Claim 16 was objected to for insufficient antecedent basis. Claims 1, 4-6, 13, 15, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ahn et al. (U.S. Patent No. 6,531,945, hereinafter “the ‘945 patent”) in view of Masuda et al. (U.S. Patent No. 6,791,444, hereinafter “the ‘444 patent”). Claims 2 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘945 patent in view of the ‘444 patent, and further in view of Ott et al. (U.S. Patent No. 6,614,093, hereinafter “the ‘4093 patent”). Claims 3 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘945 patent in view of the ‘444 patent, and further in view of Murata et al. (U.S. Patent No. 6,535,093, hereinafter “the ‘5093 patent”).

In response to the objection to the drawings, Applicant respectfully submits that the references to Figures 1-3 and 5 on pages 1 and 2 of the disclosure, upon which the objection is based, do not refer to any figure in the present application. As indicated on page 1, lines 17-18 and 24-26, and page 2, lines 4-5 and 9-11, of the disclosure, these references refer to figures in the cited Japanese patents or publications. Accordingly, the objection does not concern any of the drawings of the present application and it is respectfully requested that the objection to the drawings be withdrawn.

In response to the objection to Claim 16, Applicant has amended Claim 16 to recite “said stacked core substrate” rather than “said insulating member.” Since Claim 13 recites “a

stacked core substrate,” antecedent basis is clearly present. It is therefore respectfully requested that the objection to Claim 16 be withdrawn.

In response to the rejection of Claims 1, 4-6, 13, 15, and 17 under 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of the rejection for the reasons set forth below. The outstanding Office Action admits on page 4 that the ‘945 patent does not teach “cutting conductor of a stacked layer member and an embedding material filled in the grooves formed by the cutting,” but alleges on the same page that the ‘444 patent teaches such a feature. Applicant respectfully disagrees. In the ‘444 patent, a coil is formed by “forming an elongated winding core by extruding a kneaded material which is obtained by kneading a powdered magnetic material and a binder” and “winding a conducting wire around the winding core in a coiled manner” (col. 2, lines 36-40, emphasis added).

The Webster’s dictionary defines a groove as “a long narrow furrow cut either by a natural process or by a tool.” Therefore, since the winding core in the ‘444 patent is formed by extruding a kneaded material, Applicant respectfully submits that there is no groove formed by cutting in the ‘444 patent. Accordingly, the ‘444 patent does not teach “an embedding material filled in a groove formed by cutting said conductor of the stacked layer member” since the ‘444 patent does not disclose a groove. Further, Applicant respectfully submits that the ‘945 and ‘444 patents do not teach “conductors which are constituted by cutting conductors of a stacked layer member in U-shapes.” In fact, Applicant notes that “stacked layer member in U-shapes” is not alleged to be cured by the ‘444 patent or any other patent in the outstanding Office Action.

The outstanding Office Action further alleges on page 4 with respect to Claim 13 that the ‘945 patent teaches “a plurality of U-shaped conductors embedded within a substrate; the substrate insulating between each U-shaped conductor.” However, this does not teach or suggest “a stacked core substrate formed by stacking a plurality of core substrates, each core

substrate having U-shaped conductor corresponding to three sides of plural rectangular helical coils,” as recited in Claim 13. The ‘945 patent discloses a plurality of conductive posts, but only a single substrate 110 (col. 1, lines 42-45).

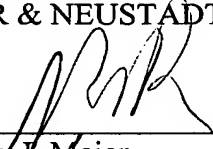
The outstanding Office Action does not allege that the ‘4093 and ‘5093 patents disclose the aforementioned elements not taught by the ‘945 and ‘444 patents. Accordingly, the combination of elements fails to disclose the same positively recited limitation not taught by the references individually. Thus, the subject matter of Claims 1 and 13 is not rendered obvious and Claims 1 and 13 and dependent Claim 4-6, 15, and 17 are patentable over the applied references. It is therefore requested that the outstanding rejection of Claims 1, 4-6, 13, 15, and 17 be withdrawn.

In response to the rejection of Claims 2, 3, 14, and 16 under 35 U.S.C. § 103(a), the outstanding Office Action does not allege that the ‘4093 and ‘5093 patents disclose the aforementioned elements of independent Claims 1 and 13 not taught by the ‘945 and ‘444 patents. Accordingly, the combination of elements fails to disclose the same positively recited limitation not taught by the references individually. Thus, the subject matter of Claims 2, 3, 14, and 16 is not rendered obvious and Claims 2, 3, 14, and 16 are patentable over the applied references. It is therefore requested that the outstanding rejection of Claims 2, 3, 14, and 16 be withdrawn.

Consequently, it is believed that the application is in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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